

35 U.S.C. §102 REJECTION USING NOVOGROD

The non-final Office Action rejects claims 1-4 under 35 U.S.C. §102(e) as being anticipated by cited portions of U.S. Pat. No. 6,367,693 to Novogrod ("Novogrod").

Applicant respectfully disagrees with this assertion as limitations in the application are neither taught nor suggested by Novogrod. More specifically, Novogrod does not teach or suggest: (1) "generating a money order" and "sending said generated money order to said intended receiver" as required by claim 1; and (2) transmission or processing of a credit card to make available funds for purchasing the money order as required by claim 3.

Novogrod dispenses a money order at a designated dispenser by communicating with a bank computer. See Novogrod, claim 1; and c. 21, l. 60-65. The sender is a customer of the bank. Presumably, the customer has an account with the bank that serves as the source of the funds for the money order. Notably, Novogrod does not teach or suggest sending the money order after it is dispensed. Further, Novogrod doesn't suggest using a credit card as the source of funds for the money order. For at least these reasons, claims 1-4 are not anticipated by Novogrod.

35 U.S.C. §103 REJECTION USING NOVOGROD AND BARZILAI

The non-final Office Action rejects claims 5-22 under 35 U.S.C. §103(a) as being unpatentable over Novogrod in view of cited portions of U.S. Pat. No 6,012,045 to Barzilai et al. ("Barzilai"). Applicant respectfully disagrees with this assertion. More specifically, Applicant believes a *prima facie* case of obviousness has not been properly set forth in the non-final Office Action with regard to a rejection of claims 5-22 in their current form. The Examiner is charged with putting forth a *prima facie* showing of obviousness. The basic test is excerpted below:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP, Original Eighth Edition, August 2001, §2143.

Applicant believes the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness.

Teachings Missing from Cited References

With regard to the third prong of the above obviousness test, Applicant believes Novogrod and Barzilai do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, neither Novogrod nor Barzilai teaches or suggests: (1) delivering or sending the generated money order as generally required by claims 5, 16, 19 and 22; (2) causing a money order request selection to be displayed by the Internet-based auction site as required by claim 11; (3) requesting and receiving funds for the money order as required by claim 11; and (4) authorizing debiting of a card in the money order request as is generally required by claims 3, 8, 20, and 23. For least these reasons, Applicants respectfully request for reconsideration of the rejection to the claims.

First Missing Limitation: Money Order Delivery

As first stated above, claims 5, 16, 19, and 22 generally require delivery of the generated money order. The Office Action takes the position that Novogrod teaches this limitation. However, Novogrod only teaches sending dispensing information to a designated instrument dispenser that prints the money order without any subsequent sending step. See Novogrod, c. 19, l. 23-32. The claimed sending step allows payment for an auction or other obligation without visiting a bank or posting the money order in one embodiment.

Second Missing Limitation: Display of a Money Order Selection

Claim 11 requires display of a money order request selection to be displayed by the Internet auction web site. Novogrod doesn't teach a money order selection link, icon or button and doesn't even contemplate the Internet auction web site. Barzilai, which does relate to auctions, does not teach a link, icon or button that allows selection of money order payment. By integrating the money order selection in the auction site, payment with a money order is facilitated in one embodiment of the claimed invention.

Third Missing Limitation: Request & Receive Funds

Claim 11 further requires a requesting funds for the money order and confirming receipt of those funds. Novogrod only teaches working with a "bank customer" who requests the money order. As such there is no need for the customer's bank to request funds upon receipt of the money order request as the bank in Novogrod would simply debit the customer's account. Accordingly, there would be neither a request nor a receipt of funds in Novogrod. The claimed invention allows external funding sources that makes payment more convenient in one embodiment of the claimed invention.

Fourth Missing Limitation: Purchasing Money Order with Card

Claims 3, 8, 20, and 23 generally require use of a card in the purchase of the money order. In contrast, Novogrod only works with bank customers and presumably, uses the customer's bank account to pay for the money order. Many consumers prefer use of a credit card for purchases such that this embodiment of the claimed invention has significant advantages over Novogrod.

Motivation to Combine Novogrod and Barzilai

The first prong of the obviousness test requires, a suggestion or motivation to combine references to avoid hindsight reconstruction of the claimed invention based upon the information disclosed in the present application. The last paragraph of section 5 of the Office Action appears to address the motivation to combine Novogrod and Barzilai

but the Applicants cannot discern the nature of this argument. The Office Action appears to rely upon Official Notice that there are motivations for one of ordinary skill in the art to combine Novogrod and Barzilai. Applicant respectfully requests a showing of documentary proof for the apparent Official Notice set forth as the motivation to combine these references. See MPEP 2144.03.

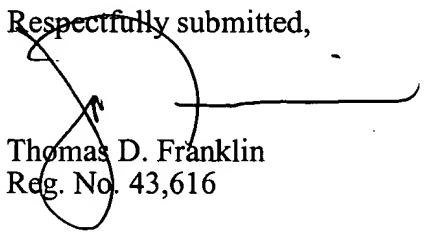
Reasonable Likelihood of Success in Combining Novogrod and Barzilai

The second prong of the obviousness test requires a reasonable likelihood of success in making a proposed combination. Novogrod relates to the complex world of banking and Barzilai relates to online auctions. The banking industry is tremendously complex such that it is unclear how one of ordinary skill in the art would modify Barzilai to allow for payment with money orders. Such major modifications would certainly have little likelihood of success. How would one of ordinary skill in the art hope to combine these references with any likelihood of success?

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. Reconsideration of the rejections is respectfully requested. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 303-571-4000.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (As Filed) A method of purchasing a money order via the internet, comprising the steps of:

providing a money order system capable of generating money orders;
contacting the money order system via the internet by a user desiring to purchase a money order in a predefined amount;

transmitting information to the money order system via the internet required to purchase said money order, said information including at least a user's identification, an identification of an intended receiver of the money order and an financial amount for the money order;

generating a money order from said money order system upon receipt of said transmitted information; and

sending said generated money order to said intended receiver.

2. (As Filed) A method of purchasing a money order via the internet as recited in claim 1 further including the step of generating an e-mail message to at least one of said user or intended receiver of said money order that said money order has been sent to said intended receiver.

3. (As Filed) A method of purchasing a money order via the internet as recited in claim 2 further including the steps of:

transmitting credit card information associated with said user; and
electronically processing said credit card information to make available funds needed for said purchase of said money order by said user.

4. (As Filed) A method for purchasing a money order via the internet as recited in claim 2 further including the steps of:

establishing a funds account on said users behalf in said money order system, said funds account having a predetermined amount of monetary funds;

electronically deducting a predetermined amount of funds from said funds account in accordance with the amount of funds required to generate said users purchased money order.

5. (As Filed) A method of purchasing a money order from a money order system via the internet for the purchase of goods purchased from an internet-based auction transaction, the method including the steps of:

awarding a bid to a buyer for goods to be purchased from a seller from an auction process conducted between said buyer and seller via the internet on an internet auction site;

contacting said an internet site for said money order system via the internet by said buyer after said bid is awarded to said buyer;

transmitting information to said money order system via the internet by said buyer to purchase said money order for said sale of said goods, said information including at least said buyers identification, an identification of said seller and a financial amount for the money order;

generating a money order from said money order system upon receipt of said transmitted information from said buyer;

delivering from money order system said generated money order to said seller; and

delivering said goods from said seller to buyer after said money order is generated.

6. (As Filed) A method as recited in claim 5 further including the step of providing a hyper-link in the auction site to the money order system site.

7. (As Filed) A method as recited in claim 6 further including the step of generating a message to at least one of said buyer or seller stating that said money order has been sent to said seller.

8. (As Filed) A method as recited in claim 7 further including the steps of:

transmitting credit card information associated with said buyer to said money order system internet site; and

electronically processing said credit card information to make available funds needed for said purchase of said money order by said buyer in said money order system site.

9. (As Filed) A method as recited in claim 7 further including the steps of:

establishing a funds account on said buyers behalf in said money order system, said funds account having a predetermined amount of monetary funds;

electronically deducting a predetermined amount of funds from said funds account in accordance with the amount of funds required to generate said money order generated for the buyer.

10. (As Filed) A method as recited in claim 7 further including the step of shipping the goods from said seller to buyer prior to said sellers receipt of said

money order and after said information is transmitted from said money order system to said seller indicating that said money order is being delivered to said seller.

11. (As Added) A system comprising:

a server configured to conduct an internet-based auction via a web site, said server further configured to cause to be displayed, via said web site, a money order request selection selectable by a bidder that participated in an auction conducted via said web site; and

a money order sub-system that is accessed via said web site upon selection by the bidder of said money order request selection, said money order sub-system configured for processing a money order request, said processing comprising:

requesting funds for a money order transaction upon receipt of a money order request;

upon confirmation of receipt of the requested funds, instructing a money order dispensing apparatus to generate a money order; and

confirming to the bidder that the money order request has been fulfilled.

12. (As Added) A system according to Claim 11 wherein said money order sub-system comprises a money order server configured to communicate with said auction server, and a processor, said money order server coupled to said processor.

13. (As Added) A system according to Claim 12 wherein said processor is programmed to request funds for a money order transaction upon receipt of a money order request by transmitting credit card information to a billing server.

14. (As Added) A system according to Claim 12 wherein said money order server is further configured to communicate with a seller to confirm that a money order has been authorized.

15. (As Added) A system according to Claim 12 wherein said money order sub-system further comprises a database coupled to said processor, said database comprising data for submitting an electronic funds transfer request and data for money order authorizations.

16. (Amended) A money order system for processing a money order request, the money order system configured to communicate with a money order dispensing apparatus, said money order system comprising:

a server for receiving communications from and transmitting communications to a money order requestor;

a memory for storing information relating to money order transactions;

a processor coupled to said server and to said memory, said processor programmed to:

request funds for a money order transaction upon receipt of a money order request;

upon confirmation of receipt of the requested funds, instruct the money order dispensing apparatus to generate a money order before the money order is automatically sent.

17. (As Added) A system according to Claim 16 wherein said processor is further programmed to confirm to the requestor that the money order request has been fulfilled.

18. (As Added) A system according to Claim 16 wherein said memory comprises a database, said database comprising data for submitting an electronic funds transfer request and data for money order authorizations.

19. (Amended) A database, comprising:
data for submitting an electronic funds transfer request and based on a money order generation request from a requestor;
data on a completed electronic funds transfer;
data on delivery of a generated money order;
data on authorization of generation of a money order; and
data on a confirmation, for the requestor, of the money order authorization.

20. (Amended) A method for purchasing a money order utilizing a money order system, said method comprising:

submitting, to the money order system and via a wide area network, a request for a money order, the request including authorization to debit a card [an] account; and

receiving confirmation, via the wide area network, that the money order request has been fulfilled.

21. (As Added) A method according to Claim 20 wherein submitting a request for a money order comprises the steps of:

selecting a money order request selection on a web page;

entering data requesting the money order including information identifying an account to be debited; and
authorizing debiting the account.

22. (Amended) A method for generating a money order from a money order dispensing apparatus, said method comprising:

receiving, from a requestor and via a wide area network, a money order request;

requesting an electronic funds transfer upon receipt of the money order request; **[and]**

instructing the money order dispensing apparatus to generate a money order upon receipt of the funds in response to the electronic funds transfer request; and
initiating delivery of the money order after generation.

23. (As Added) A method according to Claim 22 wherein requesting an electronic funds transfer comprises transmitting credit card information to a billing server.

24. (As Added) A method according to Claim 22 further comprising the step of notifying a party that is to receive the money order that the money order has been authorized.

25. (As Added) A method according to Claim 22 further comprising the step of transmitting the money order to a party.

26. (As Added) A method of purchasing a money order via the internet as recited in claim 1, wherein the sending step is initiated by the money order system.